

**D. Double Patenting**

The Action provisionally rejects claims 20-21, 26 and 28-31 under the judicially created doctrine of obviousness-type double patenting over claims 1-13, 16, 27 and 30-31 of U.S. Application Ser. No. 09/949,268.

In response, Applicants note that Ser. No. 09/949,268 is no longer pending. It is therefore believed that the rejection is now moot and removal thereof is respectfully requested.

**E. Rejection of Claims Under 35 U.S.C. §112, Second Paragraph**

The Action rejects claim 51 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out the subject matter which Applicant regards as the invention. In particular, the Action rejects the claim for including formulas for non-elected groups, which is asserted to be confusing. Applicants respectfully traverse.

As noted in the concurrently filed Petition Under 37 CFR 1.144, the Restriction Requirement was not properly made. Each of the recited formulas is specifically linked by generic claim 20 because claim 51 depends from claim 20 and thus incorporates all of the limitations of this claim. This is because a generic claim is a claim that “should include no material element additional to those recited in the species claims, and must comprehend within its confines the organization covered in each of the species.” MPEP § 806.04(d). Each of the species here is an ectophosphatase inhibitor as recited in claim 20.

As recently noted by the Court of Appeals for the Federal Circuit, an applicant may prosecute generic, linking claims “without running afoul of the restriction requirement *because they are linking claims.*” *In re Michael P. Doyle*, 293 F.3d 1355, 1360 (Fed. Cir., 2002), *citing* MPEP §809.03 (8<sup>th</sup> ed. 2001) (emphasis added). Indeed, the Court held that the failure to present generic claims in the original prosecution of an application was an error correctable by

broadening reissue. *Id.* at 1361-1362. Further, the Federal Circuit noted that allowance of a linking claim prompts the examination of covered claims, stating that “The MPEP expressly provides that ‘[I]f a linking claim is allowed, the examiner must thereafter examine species if the linking claim is generic thereto, or he or she must examine the claims to the nonelected inventions that are linked to the elected invention by such allowed linking claim.’” *Id.* at 1362., *citing* MPEP § 809.04 (emphasis added by the Court).

In the present case, the Restriction Requirement imposed upon the claims with respect to a species of ectophosphatase inhibitor for examination would foreclose Applicants ability to have their generic linking claim properly examined. This would be in contradiction to the Federal Circuit’s holding in *Doyle* and the procedures set forth in the MPEP. Applicants therefore respectfully traverse the indefiniteness rejection, request that the Restriction Requirement be withdrawn and claim 20 be identified on the record as a generic linking claim and that the claims examined as such as required by MPEP § 809.

#### **F. Rejections Under 35 U.S.C. §102**

(1) The Action rejects claims 20-21 and 31 under 35 U.S.C. §102(b) as being anticipated by Pietkiewicz *et al.* (1998), Ujhazy *et al.* (1996) and Ujhazy *et al.* (1996). Although it is not stated so in the Action, it is believed by Applicants that the references cited correspond to references C14, C19 and C20 from the PTO form 1449. It is further believed that the second reference to “Ujhazy *et al.* (1996)” is actually referring to the Ujhazy *et al.* (1994) reference listed as C19. If any of these assumptions are incorrect, Applicants respectfully request that the Examiner note this on the record.

The rejection is made based on the assertion that the references teach administration of an ectophosphatase inhibitor to reduce drug resistance in several murine or human MDR tumor cell lines to doxorubicin. In response, Applicants respectfully traverse but note that the current claims are directed to inhibition of drug resistance in plant cells. The Action has not alleged that the references teach decreasing drug resistance in a target plant cell. It is therefore believed that the rejection is now moot and removal thereof is respectfully requested.

(2) The Action rejects claims 20-21, 26 and 28-31 under 35 U.S.C. §102(e) as being anticipated by Thomas *et al.* (US 6,448,472).

In response, Applicants note that a Declaration of J. Brian Windsor is being submitted herewith under 37 C.F.R. §1.132 establishing that the subject matter of U.S. Patent No. 6,448,472 referred to in the rejection was invented by the current inventors and thus is not “by another” pursuant to 35 U.S.C. §102(e). In view of the submission, the current rejection is now moot and removal thereof is thus respectfully requested.

#### **G. Conclusion**

In light of the foregoing, applicants submit that all claims are in condition for allowance, and an early indication to that effect is earnestly solicited. The examiner is invited to contact the undersigned (512)536-3085 with any questions, comments or suggestions relating to the referenced patent application.

**PETITION FOR EXTENSION OF TIME**

Pursuant to 37 C.F.R. § 1.136(a), Applicants petition for an extension of time of one month to and including October 7, 2004 in which to respond to the Office Action dated June 7, 2004. Pursuant to 37 C.F.R. § 1.17, the fee of \$55.00 is enclosed, which includes the process fee for a one-month extension of time. Should such request or fee be deficient or absent, consider this paragraph such a request and authorization to withdraw the appropriate fee under 37 C.F.R. §§ 1.16 to 1.21 from Fulbright & Jaworski L.L.P. Account No.: 50-1212/TEXG:003USD1.

Respectfully submitted,



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